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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/799,348      | 03/12/2004  | Kevin J. Dowling     | C1104.70122US01     | 6210             |

23628 7590 08/17/2006

WOLF GREENFIELD & SACKS, PC  
FEDERAL RESERVE PLAZA  
600 ATLANTIC AVENUE  
BOSTON, MA 02210-2206

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| EXAMINER |
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KASZTEJNA, MATTHEW JOHN

|          |              |
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| ART UNIT | PAPER NUMBER |
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3739

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

**Office Action Summary**

Application No.

10/799,348

Applicant(s)

DOWLING ET AL.

Examiner

Matthew J. Kasztejna

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/28/05, 4/11/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Notice of Amendment***

In response to the amendment filed on July 28, 2005, amended claims 1 and 3 are acknowledged. The current rejections of the claims are *withdrawn*. The following new grounds of rejection are set forth:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 9, 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,007,408 to Ioka.

In regards to claims 1, 9, 17 and 19, Ioka discloses a system and method of providing lighting for a medical environment, comprising: a medical tool having a non-lighting function (see Col. 1, Lines 10-15), a light source integrated into the tool 3, and a control facility 4 for controlling a light output of the light source to light a work area (see Figs. 1-2).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No. 5,007,408 to Ieoka in view of Patent No. 4,884,133 to Kanno et al.

**In regards to claims 2-3 and 10-11**, Ieoka discloses a system and method of providing lighting for a medical environment, wherein controlling a light output is performed by a processor but is silent with respect to the light source being a semiconductor-based light source. Kanno et al. disclose an analogous endoscope device having a LED power source 41 for providing illumination (see Fig. 1a). Kanno et al. thus demonstrate that LEDs are well known in the endoscope art for providing illumination. It would have been obvious to one skilled in the art at the time the invention was made to include a semiconductor based light source in the apparatus of Ieoka to provide an alternative means of illumination as taught by Kanno et al.

Claims 4-8 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No. 5,007,408 to Ieoka in view of Patent No. 5,665,100 to Yoon.

**In regards to claims 4-8 and 12-16**, Ieoka discloses a system and method of providing lighting for a medical environment, wherein various therapeutic instruments can be inserted through treatment channels but is silent with respect to the type of tools which can be used. Yoon teaches of an analogous endoscopic apparatus having a removable operating unit wherein the operating unit includes a hub mounting an inner tubular member removably disposed at least partly within the intermediate member and carrying operating members for performing at least one of the functions of cutting, grasping, manipulating, dissecting, collecting tissue for biopsy, penetrating tissue with a needle, injecting fluids, creating suction, aspirating, irrigating, suturing, ligating,

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visualizing, illuminating and cauterizing (See Cols. 1 and 2). Yoon thus demonstrates that exchangeable tool assemblies for an endoscope are well known in the art and furthermore, that passing the tool down a channel in the endoscopic device is also well known in the art. It would have been obvious to one skilled in the art at the time the invention was made to provide the endoscope 2 in the apparatus 1 of leoka with an exchangeable tool assembly and a channel for passing such a tool, in the manner disclosed by Yoon.

Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No. 5,007,408 to leoka in view of U.S. Patent No. 6,646,541 to Wang et al.

**In regards to claims 18-20**, leoka disclose a system 50 and is responsive to operator input (see Col. 5, Lines 4-20 and Fig. 2). Wang et al. disclose a control system 10 for a surgical instrument having a voice control interface 32 that recognizes speech from a user (see col. 5, lines 5-35). Wang et al. thus demonstrate that voice recognition interfaces for controlling medical devices are well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to provide the system 1 of leoka with a voice recognition interface, such as the one disclosed by Wang et al. for providing commands to the controller.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

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***Conclusion***

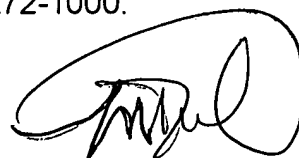
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK *mt*

8/9/6



LINDA C. M. DVORAK  
SUPERVISORY PATENT EXAMINER  
GROUP 3700